



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,425	03/29/2001	Sei-Yu Chen	DEX-0203	2890

26259 7590 09/04/2002

LICATLA & TYRRELL P.C.
66 E. MAIN STREET
MARLTON, NJ 08053

EXAMINER

DAVIS, NATALIE A

ART UNIT	PAPER NUMBER
----------	--------------

1642

DATE MAILED: 09/04/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,425

Applicant(s)

CHEN ET AL.

Examiner

Natalie A. Davis

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6 and 9, drawn to a polynucleotide, oligonucleotide, vector, host cell, and a method of making a protein, classified in class 536, subclass 23.1.
 - II. Claims 7, 9, and 23, drawn to a polypeptide, classified in class 530, subclass 350.
 - III. Claim 8, drawn to an antibody, classified in class 530, subclass 387.1.
 - IV. Claims 10-14, drawn to a method of diagnosing the presence and metastases of lung cancer and staging and monitoring lung cancer, classified in class 435, subclass 7.1.
 - V. Claim 15, drawn to a method of identifying potential therapeutic agents for imaging and treating lung cancer, classified in class 424, subclass 9.341 and 134.1.
 - VI. Claims 16-17, drawn to a method of imaging lung cancer, classified in class 424, subclass 9.341.
 - VII. Claims 18-19, drawn to a method of treating lung cancer with an antibody, classified in class 424, subclass 178.1.
 - VIII. Claims 20 and 22, drawn to a method of identifying compound, which antagonize the LSG polypeptide, classified in class 424, subclass 184.1.
 - IX. Claims 20 and 21, drawn to a method of identifying compound which agonize the LSG polypeptide, classified in class 424, subclass 184.1.
 - X. Claim 24, drawn to a method of inducing an immune response against a polypeptide, classified in class 514, subclass 2.
 - XI. Claim 25, drawn to a method of treating lung cancer with a vaccine, classified in class 424, subclass 185.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I-III (products) and IV-XI (methods) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products of Groups I-III may be used for a number of different processes that are very much unrelated. For example, the antibody of Group III may not only be used in the method of Group VI-VII, but may also be used for immunopurification. Likewise, the polypeptide of Group II may be used for affinity purification of antibodies and not only in the methods of Groups IV-V and VIII-XI. The nucleic acid of Group I may be used as a probe or primer.

3. The products of Groups I-III are drawn to structurally and functionally different molecules with different immunological properties, modes of action, half-life, and target different receptors.

4. The methods of Groups IV-XI relate to methods but each method differs in method steps, modes of operation, reagents needed and serve different endpoints and effects. For example, a method of identifying a compound that agonizes is different from identifying a compound that antagonizes. Each method requires different method steps, reagents, modes of operation and effects. Likewise, treating imaging, and inducing an immune response would require different method steps, reagents, modes of operation.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, divergent subject matter, and require different search strategies, restriction for examination purposes as indicated is proper.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1642

7. Applicant is advised that the response to this requirement, to be complete, must include an election of the invention to be examined even though the requirement be traversed.

8.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Davis whose telephone number is 703-308-6410. The examiner can normally be reached on M-F 8-5:30 (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa PhD can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4315 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Natalie A. Davis, PhD
September 3, 2002


SHEELA HUFF
PRIMARY EXAMINER